

REMARKS

Claims 1-40 are pending in the instant application.

Claims 1-40 are subject to a restriction requirement.

Restriction Requirement

Claims 1-40 are subject to a restriction requirement under 35 U.S.C. § 121 as follows:

Group I: Claims 1-30, drawn to a method of extrusion, classified in class 264, subclass 210.2.

Group II: Claims 31-40, drawn to a dual undersill trim component, classified in class 428, subclass 121.

The restriction requirement under 35 U.S.C. § 121 is respectfully traversed. Applicants, however, provisionally elect the invention of Group II, Claims 31-40.

The Examiner has also claimed that the inventions in Groups I and II are distinct. The Examiner citing MPEP § 806.05(f), states that "inventions are distinct if either or both of the following can be shown: (1) the process as claimed can be used to make another materially different product, or (2) that the product as claimed can be made by another and materially different process." The Examiner has stated that the product as claimed can be made by another and materially different process such as one that extrudes a product containing at least one of the bends thereby eliminated at least one of the bending steps. However, with regard to the restriction, whether or not the article of Group II could be produced with a molding apparatus different from Group I is not believed to be determinative of the issue of distinctiveness.

The Examiner has also indicated in the Office Action that because the inventions of Group I and II have acquired a separate status in the art as shown by their different classification, restriction for examination purposes is proper. Applicants respectfully disagree. The PTO classification system is not controlling when determining unit of invention, and has long been held as insufficient grounds upon which to base a restriction requirement. *Ex parte Milas*, 71 U.S.P.Q. 212 (Bd. App. 1946), *Ex parte Musselman*, 94 U.S.P.Q. 212 (Bd. App. 1949).

The potential burden upon Applicants in securing meaningful patent protection clearly outweighs those at the PTO. The court in *Weber* stated:

We have decided in the past that 112, second paragraph, which states in part ' [t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicants regard as the invention,' allows the inventor to claim the invention as he contemplates it." *In re Weber*, 198 U.S.P.Q. 328, 331 (C.C.P.A. 1978).

Furthermore, when weighing the effect of "such administrative matters as examiner case loads and the amount of searching done per filing fee" versus the statutory rights of the Applicants, the *Weber* court stated, "We conclude that the statutory rights [of the applicant] is paramount." *Id.* at 332.

Applicants therefore respectfully request the Examiner reconsider the restriction of the invention in view of Applicants' arguments as provided herein, and proceed with examination of claims 1-40 of the instant invention.

Should the Examiner believe that issues remain outstanding, the Examiner is respectfully requested to call Applicant's undersigned attorney in an effort to resolve such issues and advance this application to issue.

Respectfully submitted,

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